

REMARKS

The Office Action of January 15, 2003 has been received and its contents carefully considered.

Claim 2 has been rejected under the second paragraph of 35 U.S.C. § 112 as indefinite.

The Examiner states that the scope of protection sought for the compounds of formula (I) is confusing as to whether the scope of Y and Z is limited to Y-1 to Y-26 or otherwise. The Examiner states that "Y, Z and L" set forth in lines 3 to 11 of claim 2 have a scope which is beyond the scope presented in the ring forming a condensed ring Y-1 to Y-26.

The Examiner states that, for example, when L is 1, there are two methine groups associated with the condensed ring, and the heterocyclic ring defining Y and Z may contain atoms other than S, N and O presented in formula Y-1 to Y-26.

Applicants first note that the Examiner's reference to "L" appears to be in error, since claim 2 does not contain the term "L". Applicants believe that the Examiner intended to refer to "p", which defines the number of times that the " $(L^1 = L^2)$ " group appears in the compound of formula (I).

Applicants do not agree with the Examiner that claim 2 is indefinite.

The beginning portion of claim 2 that the Examiner refers to at lines 3 to 11 sets out a broad definition, but this definition is then limited by the requirement set forth later on in claim 2 that the "condensed ring containing Y and Z in the methine dye represented by formula (I) is selected from the following Y-1 to Y-26". Thus, claim 2 specifically limits the scope of Y and Z

AMENDMENT UNDER 37 C.F.R. § 1.111

U.S. Application No. 09/931,309

Q65828

to Y-1 to Y-26. Applicants see no basis for the Examiner to assert that claim 1 can be interpreted in a manner in which the scope of scope of formula (I) is not so limited.

Further, with respect to “p”, claims 2 states that p represents 0 or 1. Substituents Y-25 and Y-26 are examples where two methine groups would be associated with the condensed ring. Thus, the scope of “p” is correct.

In view of the above, applicants submit that claim 2 complies with the requirements of the second paragraph of 35 U.S.C. § 112 and, accordingly, request withdrawal of this rejection.

Claims 3 and 5 to 9 have been rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over JP 62-204250 (JP ‘250).

Applicants have cancelled claim 3, leaving only claims 5 to 9 being subject to this rejection.

Applicants submit that JP 250 does not disclose or render obvious claims 5 to 9 and accordingly, request withdrawal of this rejection.

Applicants have amended claim 5, from which claims 6 to 9 depend, to place it in independent. In amending claim 5, applicants have amended the definition of X⁶¹ so that it no longer refers to a tellurium atom.

The Examiner relies on Compound 17 at page 311 of JP ‘250, and Compound 73 at page 315 of JP ‘250, as being compounds that are within the scope of the present invention.

In addition, the Examiner relies on compounds on pages 311 to 313 of JP ‘250 for compounds wherein the methine dyes contain 1, 2 or 3 methine groups. The Examiner does not identify any specific compounds on these pages of JP ‘250.

AMENDMENT UNDER 37 C.F.R. § 1.111

U.S. Application No. 09/931,309

Q65828

Compounds 17 and 73 of JP '250 are compounds that contain a tellurium atom in a position corresponding to X⁶¹ of the present claims 5 to 9. As discussed above, applicants have amended claim 5 so that X⁶¹ no longer refers to a tellurium atom.

Accordingly, applicants submit that Compounds 17 and 73 of JP '250 are not within the scope of the present claims. Further, none of the other compounds on pages 311 to 313 of JP '250 are within the scope of the present claims.

In view of the above, applicants submit that JP '250 does not disclose or render obvious the subject of matter claims 5 to 9 and, accordingly, request withdrawal of this rejection.

Claims 1, 3 and 4-9 have been rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over JP 61-277950 (JP '950).

As mentioned above, claim 3 has been cancelled. Thus, only claims 1 and 4 to 9 remain subject to this rejection.

Applicants submit that JP '950 does not disclose or render obvious the subject matter of claims 1 and 4 to 9, as well as new claims 11 to 13 and, accordingly, request withdrawal of this rejection.

The Examiner asserts that Compound 112 at page 577 of JP '950 is within the scope of the present claims.

The Examiner also asserts that Compounds 90 and 103 on page 576 of JP '950 are within the scope of the present claims.

AMENDMENT UNDER 37 C.F.R. § 1.111

U.S. Application No. 09/931,309

Q65828

In addition, the Examiner states that there are compounds on page 571 of JP '950 that contain 1, 2 and 4 methine groups. The Examiner does not identify any specific compounds on page 571.

Claims 5 to 9 are directed to a silver halide photographic material that contains a methine dye represented by formula (XXX), which contains a thiophene condensed ring. Compounds 90, 103 and 112 of JP '950 contain a thiophene condensed ring, wherein the thiophene ring is condensed with a tellurazole ring. As discussed above, claim 5 has been amended so that X⁶¹ does not represent a tellurium atom, and therefore does not represent a tellurazole ring. Compounds 90, 103 and 112 of JP '950 are not within the scope of claim 5, or the claims dependent thereon. Further, none of the other compounds disclosed in JP '950 are within the scope of claim 5, or the claims dependent thereon.

With respect to claim 1, applicants have amended claim 1 so that Y represents a furan ring and no longer refers to pyrrole ring.

Compound 112, at page 577 of JP '950, and Compounds 90 and 103, at page 576 of JP '950, are not within the scope of claim 1 as amended above, or dependent claim 4, since none of these compounds contain a furan ring. Further none of the other compounds of JP '950 are within the scope of claims 1 and 4.

Applicants have added new claims 11 to 13, with claim 11 being in independent form and being identical to claim 1, except that in claim 11, Y is a pyrrole ring. Thus, claim 11 is directed to the subject matter that was deleted from claim 1. Claim 12 depends from claim 11. Support for claim 12 can be found at page 21, lines 5 to 7 of the specification. Claim 13 depends from

AMENDMENT UNDER 37 C.F.R. § 1.111

U.S. Application No. 09/931,309

Q65828

claim 11, and has the same constitution as amended claim 4, except that Y⁵¹ in formula (XX) represents a pyrrole ring.

Compounds 90 and 103 of JP '950 that were cited by the Examiner do not contain a pyrrole ring and, thus, are not within the scope of claim 11.

Compound 112 of JP '950, as depicted at page 577 of JP '950, has a structure that is asserted by the Examiner to contain a pyrrole ring, but applicants submit that the structure shown for Compound 112 does not contain a pyrrole ring, and that one of ordinary skill in the art would recognize that the structure shown for Compound 112 contains a mistake. In particular, if the ring which the Examiner considers to be a pyrrole ring was, in fact, a pyrrole ring, a hydrogen atom or a substituent would be attached to the nitrogen atom of the pyrrole ring. The nitrogen atom shown in Compound 112 however, does not contain any such attachment and, thus, cannot be considered to be a pyrrole ring. Applicants believe that the structure shown for Compound 112 contains a clerical error, and that the nitrogen atom was intended to be a sulfur (S) atom, as set forth in the thiophene ring on the left-hand side of Compound 112. Such a structure would be consistent with an atom that does not contain any attachment. Accordingly, applicants submit that JP '950 does not defeat the patentability of new claim 11, and the claims dependent thereon.

In view of the above, applicants submit that claims 1, 4 to 9 and 11 to 13 are patentable over JP '950 and, accordingly, request withdrawal of this rejection.

Claim 3 has been rejected under 35 U.S.C. § 102(a) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over JP-A-P2000-63690.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/931,309

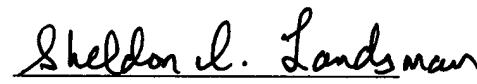
Q65828

As discussed above, claim 3 has been cancelled. Accordingly, applicants submit that this rejection is moot.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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WASHINGTON OFFICE



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PATENT TRADEMARK OFFICE

Date: July 15, 2003

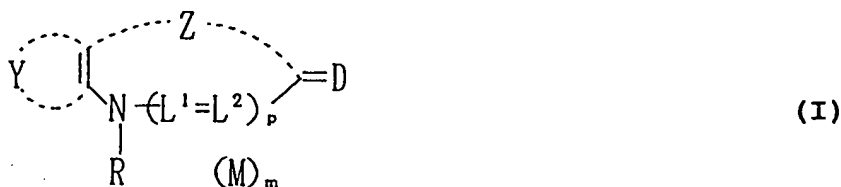
APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 3 is canceled.

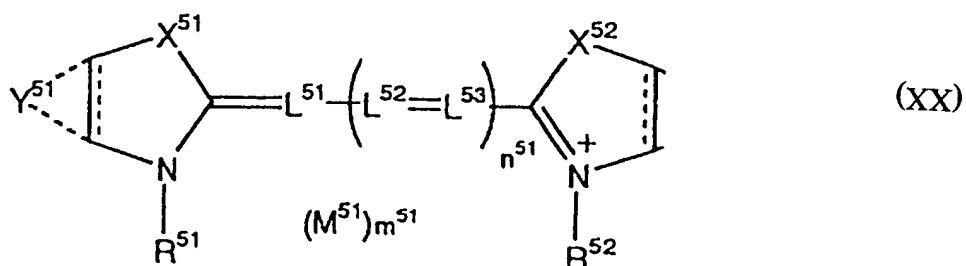
The claims are amended as follows:

1. (Amended) A silver halide photographic material which comprises at least one methine dye represented by the following formula (I) :



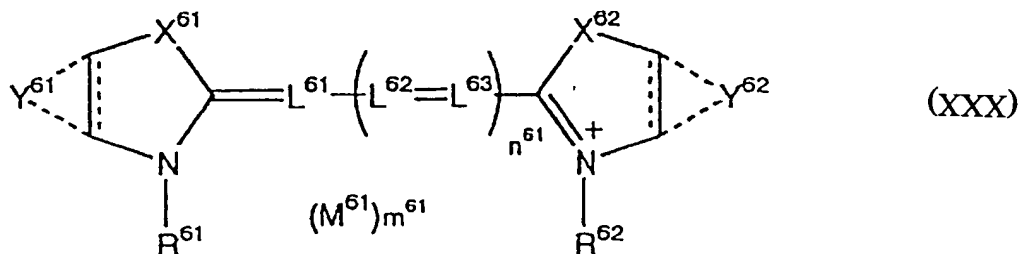
wherein Y represents a furan ring ~~or a pyrrole ring~~, and Y may further be condensed with other 5- or 6-membered carbocyclic ring or heterocyclic ring, or may have a substituent; the bond between two carbon atoms in which Y is condensed may be a single bond or a double bond; Z represents an atomic group necessary to form a 5- or 6-membered nitrogen-containing heterocyclic ring, and Z may further be condensed with other 5- or 6-membered carbocyclic ring or heterocyclic ring; R represents a substituted or unsubstituted alkyl group, aryl group, or heterocyclic group; D represents a group necessary to form a methine dye; L¹ and L² each represents a methine group; p represents 0 or 1 ; M represents a counter ion; and m represents a number of 0 or higher necessary to neutralize the charge in the molecule.

4. (Amended) The silver halide photographic material as claimed in claim 1, wherein the methine dye represented by formula (I) is represented by the following formula (XX):



wherein Y^{51} represents a furan ring or a pyrrole ring which may be condensed with other 5- or 6-membered carbocyclic or heterocyclic ring or may have a substituent, and two carbon atoms to which Y^{51} is condensed may be bonded by a single bond or a double bond; X^{51} and X^{52} each represents an oxygen atom, a sulfur atom, a selenium atom, a tellurium atom, a nitrogen atom, or a carbon atom; Y^{52} represents an atomic group necessary to form a benzene ring or a 5- or 6-membered unsaturated heterocyclic ring, which may further be condensed with other 5- or 6-membered carbocyclic or heterocyclic ring or may have a substituent, and two carbon atoms to which Y^{52} is condensed may be bonded by a single bond or a double bond; R^{51} and R^{52} each represents a substituted or unsubstituted alkyl group, a substituted or unsubstituted aryl group, or a substituted or unsubstituted heterocyclic group; L^{51} , L^{52} and L^{53} each represents a methine group; n^{51} represents 0, 1, 2, 3 or 4; M^{51} represents a counter ion; and m^{51} represents a number of 0 or higher necessary to neutralize the charge in the molecule.

5. (Amended) ~~The A~~ silver halide photographic material ~~as claimed in claim 3, wherein~~
~~the which comprises at least one methine dye represented by formula (I) is represented by the~~
following formula (XXX):



wherein Y^{61} represents a thiophene ring which may be condensed with other 5- or 6-membered carbocyclic or heterocyclic ring or may have a substituent but is substituted with at least one halogen atom, and two carbon atoms to which Y^{61} is condensed may be bonded by a single bond or a double bond; X^{61} ~~and represents an oxygen atom, a sulfur atom, a selenium atom, a nitrogen atom or a carbon atom;~~ X^{62} ~~each represents an oxygen atom, a sulfur atom, a selenium atom, a tellurium atom, a nitrogen atom, or a carbon atom;~~ Y^{62} represents an atomic group necessary to form a benzene ring or a 5- or 6-membered unsaturated heterocyclic ring, which may be condensed with other 5- or 6-membered carbocyclic or heterocyclic ring or may have a substituent, and two carbon atoms to which Y^{62} is condensed may be bonded by a single bond or a double bond; R^{61} and R^{62} each represents a substituted or unsubstituted alkyl group, a substituted or unsubstituted aryl group, or a substituted or unsubstituted heterocyclic group; L^{61} , L^{62} and L^{63} each represents a methine group; n^{61} represents 0 or 1; M^{61} represents a counter ion; and m^{61} represents a number of 0 or higher necessary to neutralize the charge in the molecule.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/931,309

Q65828

Claims 11 to 13 are added as new claims.